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Remarks

Summary of Rejections and Objections

All claims stand rejected for double patenting in light of the U.S. Appln No. 10/286,937.

Claim 28 is rejected under 35 USC §112 (2nd ¶) as indefinite.

Claims 1-2, 4, 7-15, and 17-34 stand rejected under 35 U.S.C. 102(b)/103(a) as being anticipated by, or in the alternative, obvious over Armanic, US 6,113,711. (Office Action, ¶ 13)

Claims 1-2, 15, 17, 19-24, 26, 28, 30, 32-33 stand rejected under 35 U.S.C. 103(a) as being obvious in light of Armanic, US 6,113,711. (Office Action ¶ 15)

Claims 1-2, 15, 17-18, 20-26, 28, 30, 32-33 stand rejected under 35 U.S.C. 102(b)/103(a) as being anticipated by, or in the alternative, obvious over Liu, US Pub. 2001/00200501. (Office Action ¶ 17).

Claims 1-2, 15, 17-18, 20-26, 28, 30, 32-33 stand rejected under 35 U.S.C. 102(e) as being anticipated by, or in the alternative, obvious over Liu, US 6,325,869. (Office Action ¶ 19).

Claims 1-2, 15, 17-18, 20-26, 28, 30, 32-33 stand rejected under 35 U.S.C. 102(a) as being anticipated by, or in the alternative, obvious over Karabin, US 5,863,359. (Office Action ¶ 21).

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Claims 1-2, 15, 17, 20-23, 28, and 30 stand rejected under 35 U.S.C.

102(e)/103(a) as being anticipated by, or in the alternative, obvious over Takemoto, US Pub. 2002/0043460. (Office Action ¶ 23).

Claims 1-2, 15, 17, 20-23, 28, 30, 30 and 33 stand rejected under 35 U.S.C.

102(e)/103(a) as being anticipated by, or in the alternative, obvious over Yoshihara, US Pub. 2002/0014287. (Office Action ¶25).

Claims 1-2, 15, 17, 20-24, 28, 30, and 32-33 stand rejected under 35 U.S.C.

102(a, b)/103(a) as being anticipated by, or in the alternative, obvious over Yamashita, US 6,231,995 or Yamashita JP Pub.11-071624. (Office Action ¶ 27).

Claims 3, 5-6 and 16 were objected to as being dependant upon rejected claims, but were determined to be allowable if rewritten in independent form.

Legal Precedent Regarding Sections 102 and 103

Before addressing the above rejections under § 102 and § 103, the Applicants would like to respectfully address legal precedent regarding 35 U.S.C. §§ 102 and 103. In *Minnesota Mining & Mfg. Co. v. Johnson & Johnson*, 976 F.2d 1559 (Fed.Cir.1992), the Court held that “under 35 U.S.C. § 102, anticipation of a patent claim must be proven by showing that each element of the claim in issue is found, either expressly or under principles of inherency, in a single prior art reference”. Furthermore, the Court in *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264 (Fed.Cir.1991) held that “to establish inherency, the extrinsic evidence must make clear that the missing descriptive

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matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient". Finally, in *Ex Parte Levy*, 17 USPQ2d 1461 (Bd. Pat. App. & Inter. 1990), the Board held that "in relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art".

Section 103 involves a different approach from section 102. Under § 103, a patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 if the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. 35 U.S.C. § 103(a). The language "obvious at the time the invention was made" has been held by the Courts to mean that it is inappropriate for the Examiner to use "hindsight" in determining obviousness. *Panduit Corp. v. Dennison Mfg. Co.*, 774 F.2d 1082 (Fed. Cir.1985). The Court in *In re Vaeck* held that "a proper analysis under § 103 requires, inter alia, consideration of two factors: (i) whether there is some suggestion or motivation, either in the reference themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings and (ii) whether the prior art would have revealed that in so making or carrying out, those

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of ordinary skill would have a reasonable expectation of success. Both the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure". *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

Application No. 10/287,937 will be allowed to go abandoned in favor of the present application. Applicant understands that this renders moot the statutory and judicial double patenting rejections of ¶¶ 5 and 7 of the office action. Withdrawal of these rejections is requested.

Response to the Rejections of Paragraphs Nine to Twenty-Seven

In paragraph 9 of the office action, Claim 28 is rejected as indefinite. However, one of ordinary skill, reading and understanding the application text, would have no trouble, understanding the metes and bounds of the claim. However, Applicants' have nonetheless amended claim 28 to further clarify the claim and remove any potential problems caused by a minor grammatical discrepancy.

In paragraph 13 of the office action, Claims 1-2, 4, 7-15, and 17-34 are rejected under 35 U.S.C. 102(b)/103(a) as being anticipated by, or in the alternative, obvious over Armanic, US 6,113,711. However, Armanic's disclosure of a "tortuous path" refers to an angled die. This would eliminate fiber texture in the extruded component. It does not

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disclose, suggest or otherwise make obvious extruded structural members with local geometries within the member that have increased fiber texture. Withdrawal of this rejection is therefore requested.

In paragraph 15 of the office action, Claims 1-2, 15, 17, 19-24, 26, 28, 30, 32-33 are rejected under 35 U.S.C. 103(a) as being obvious over Sugio (JP publication 04-022508) in light of Armanie, US 6,113,711. Again, Armanie's disclosure of a "tortuous path" refers to the die angle, it does not refer to local areas or geometries with increased fiber texture, and no one of ordinary skill would be motivated to modify Armanie based on Armanie's disclosure. Nor does Sugio improve upon this deficiency. Sugio is apparently using a conventional, pre-extrusion homogenization and extrusion shapes that would not produce (nor would be understood to produce) a substantially unrecrystallized microstructure and increased fiber texture in local areas. Instead, Sugio is directed to reducing the strength difference between a thick part and a thin part of an extrusion by extruding through two molding holes so that the microstructures are identical throughout the component. Sugio, like Armanie, simply does not teach having a local geometry with increased fiber texture in local areas. Withdrawal of this rejection is therefore requested.

In paragraph 17 of the office action, claims 1-2, 15, 17-18, 20-26, 28, 30, 32-33 are rejected under 35 U.S.C. 102(b)/103(a) as being anticipated by, or in the alternative, obvious over Liu, US Pub. 2001/00200501. However, Liu, et al., neither teaches, discloses or suggests to those of ordinary skill using local geometries to create areas of substantially unrecrystallized microstructure and increased amounts of fiber texture within

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an extruded product. Instead, Liu teaches extruding the product to produce an unrecrystallized microstructure. One of ordinary skill would moreover understand this to mean that the extruded product of Liu had a substantially unrecrystallized microstructure throughout, not that in an local area of the structure itself, there is an unrecrystallized microstructure and increased fiber texture. Withdrawal of this rejection is therefore requested.

In paragraph 19 of the office action, claims 1-2, 15, 17-18, 20-26, 28, 30, 32-33 are rejected under 35 U.S.C. 102(e) as being anticipated by, or in the alternative, obvious over Liu, US 6,325,869. Again, nothing in the Liu '869 patent teaches, discloses or suggests the presence or use of a local areas of substantially unrecrystallized microstructure and increased fiber texture within an extruded product, but instead, to extrude the product to produce an unrecrystallized microstructure. One of ordinary skill would moreover understand this to mean that the extruded product of Liu '869 patent had a substantially unrecrystallized microstructure throughout, not in an area of the structure itself. Withdrawal of this rejection is therefore requested.

In paragraph 21 of the office action, claims 1-2, 15, 17-18, 20-26, 28, 30, 32-33 are rejected under 35 U.S.C. 102(a) as being anticipated by, or in the alternative, obvious over Karabin, US 5,863,359. Nothing in the Karabin '359 patent teaches, discloses or suggests an extruded product having areas of substantially unrecrystallized microstructure and increased amounts of fiber texture within local areas of the extruded structural member. Instead, Karabin teaches an alloy product that can be used for lower plate or

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stringer extrusions. Given the conventional stringer and plate geometries depicted in Fig. 1, one of ordinary skill would moreover understand this to mean that the extruded stringer products disclosed in the Karabin '359 patent have a substantially unrecrystallized microstructure throughout, not in local areas of the stringer or plate themselves. Withdrawal of this rejection is therefore requested.

In paragraph 23 of the office action, claims 1-2, 15, 17, 20-23, 28, and 30 stand rejected under 35 U.S.C. 102(e)/103(a) as being anticipated by, or in the alternative, obvious over Takemoto, US Pub. 2002/0043460. Takemoto teaches a valve device for a refrigeration system that may be made from extruded, 6xxx alloy with allegedly improved inter granular corrosion resistance. In addition to not teaching or suggesting local areas of increased fiber texture, Takemoto does not suggest, teach or describe, *inter alia*, an extruded structural member, nor would one of ordinary skill would not be motivated to modify Takemoto or otherwise combine it with other art, in order to reach the present invention. Withdrawal of this rejection is therefore requested.

In paragraph 25 of the office action claims 1-2, 15, 17, 20-23, 28, 30, 30 and 33 stand rejected under 35 U.S.C. 102(e)/103(a) as being anticipated by, or in the alternative, obvious over Yoshihara, US Pub. 2002/0014287, based primarily on Fig. 1 of the application, which appears to show a square structure, i.e. one with an aspect ratio of about 1. It is respectfully suggested that the examiner has misapprehended the teaching of Yoshihara's Fig. 1, in that the structure depicted is a hollow tube, square in diameter, but having a uniform wall thickness. It does not teach, suggest or describe *inter alia* a

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local area with intentionally increased fiber texture, nor would one of ordinary skill would not be motivated to modify Yoshihara or otherwise combine it with other art, in order to reach the present invention. Withdrawal of this rejection is therefore requested.

Finally, in paragraph 27 of the office action, claims 1-2, 15, 17, 20-24, 28, 30, and 32-33 stand rejected under 35 U.S.C. 102(a, b)/103(a) as being anticipated by, or in the alternative, obvious over Yamashita, US 6,231,995 (or Yamashita JP Pub.11-071624). Again, it is respectfully suggested that the examiner has misapprehended the teaching of Yamashita's Fig. 1, in that the structure depicted is a hollow tube, approximately square in diameter, but having a uniform wall thickness. The "ribs" referred to by the examiner are extensions of the wall and would not promote axisymmetric extrusion. Withdrawal of this rejection is therefore requested.

All of the rejections and objections in the office action having been traversed, withdrawal of the rejections under 35 USC 102 and 103 to all claims as amended respectfully requested.

It is respectfully submitted that the present application is in condition for allowance. If the Examiner would like to suggest changes of a formal nature to place this application in better condition for allowance, a telephone call to Applicants' undersigned attorney would be appreciated.

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Finally, the fees for this submission are to be deducted by credit card according to the enclosed form PTO-2038. Additionally, authorization is hereby given to charge any underpayments or credit any overpayments to the same.

Respectfully submitted,

CUSTOMER NUMBER

08840

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